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EXAMINER

LIU, ERIC

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,133

Applicant(s)

SANSONE ET AL.

Examiner

Eric Liou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/29/03 and 5/17/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 134 (Figure 2). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities: grammatical errors. "To" should be inserted between "due" and "the" in lines 5 and 8. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 9 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 9 recites the limitation "the business item" in line 4. There is insufficient antecedent basis for this limitation in the claim. In addition, it is unclear whether "the business item" is the same item as "the item" stated in line 2. The Examiner is taking "the business item" (line 4) to be the same item as "the item" in line 2.

4. Claim 17 recites the limitation "the expiration date" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1, 2-3, 5, 7-8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Young, U.S. Patent No. 7,058,581.

7. As per claim 1, Young teaches charging a sender's meter located in the first country for postage that is due to the second carrier for processing business reply mail that is deposited by a recipient with the second carrier (Young: Figure 1); and charging a sender's meter located in the

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first country for postage that is due to the first carrier for business reply mail that is received from the second carrier and delivered to a party located in the first country (Young: Figure 1). Young teaches a return system that allows a consumer to return a product using a third-party delivery service (Young: column 2, lines 63-65). Young further teaches a return label can contain a return center address and have pre-paid postage or billing of any type (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of mail to be charged to the original sender's meter. Young teaches the package delivery service includes international carriers such as the United Parcel Service or any international postal service (Young: column 4, lines 23-27). Young further teaches for international locations, any local delivery service can be used, including a foreign postal service (Young: column 4, lines 33-35). The Examiner notes, Young teaches that the first carrier of the first country and the second carrier of the second country can be the same or different carrier.

8. As per claim 2, Young teaches the method of claim 1 as described above. Young further teaches the party is the sender (Young: Figure 1). Young teaches a product is returned from the consumer to the supplier (Young: Figure 1, "136"). The Examiner notes, the supplier is the origin of the product and is considered to be the sender.

9. As per claim 3, Young teaches the method of claim 1 as described above. Young further teaches paying the first carrier the amount charged to the sender's meter for the first carrier's postage (Young: column 3, lines 8-10). Young teaches a mailing return label contains pre-paid postage (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of return mail to be charged to the sender's meter. The Examiner notes, it is known in the postal art that postage charged to the sender's meter results in the carrier being paid. The applied reference has

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been interpreted and applied assuming basic knowledge of one of ordinary skill in the art.

According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.

10. As per claim 5, Young teaches the method of claim 1 as described above. Young further teaches paying the second carrier the amount charged to the sender's meter for the second carrier's postage. Young teaches a mailing return label contains pre-paid postage (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of return mail to be charged to the sender's meter. The Examiner notes, it is known in the postal art that postage charged to the sender's meter results in the carrier being paid. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.

11. As per claim 7, Young teaches the method of claim 1 as described above. Young further teaches delivering an item containing the international business reply mail from a sender located in the first country to a recipient located in the second country (Young: Figure 1). Young teaches a consumer returns a product using a third-party delivery service (Young: column 2, lines 63-65).

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12. As per claim 8, Young teaches the method of claim 7 as described above. Young further teaches charging the sender's meter for delivering the item (Young: column 3, lines 6-10).

Young teaches returning a product with a mailing label that has pre-paid postage (Young: column 3, lines 6-10). The Examiner interprets the mailing label having pre-paid postage to be charging the sender's meter for delivering the item.

13. As per claim 10, Young teaches the method of claim 7 as described above. Young further teaches paying the first carrier the amount charged to the sender's meter for delivering the item; and paying the second carrier the amount charged to the sender's meter for delivering the item (Young: column 3, lines 6-10). Young teaches returning a product with a mailing label that has pre-paid postage (Young: column 3, lines 6-10). The Examiner interprets the mailing label having pre-paid postage to be charging the sender's meter for delivering the item. The Examiner notes, it is known in the postal art that postage charged to the sender's meter results in the appropriate carriers being paid. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young, U.S. Patent No. 7,058,581 in view of Connell et al, U.S. Patent No. 5,554,842.

16. As per claim 4, Young teaches charging a sender's meter located in the first country for postage that is due to the second carrier for processing business reply mail that is deposited by a recipient with the second carrier (Young: Figure 1); and charging a sender's meter located in the first country for postage that is due to the first carrier for business reply mail that is received from the second carrier and delivered to a party located in the first country (Young: Figure 1). Young teaches a return system that allows a consumer to return a product using a third-party delivery service (Young: column 2, lines 63-65). Young further teaches a return label can contain a return center address and have pre-paid postage or billing of any type (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of mail to be charged to the original sender's meter. Young teaches the package delivery service includes international carriers such as the United Parcel Service or any international postal service (Young: column 4, lines 23-27). Young further teaches for international locations, any local delivery service can be used, including a foreign postal service (Young: column 4, lines 33-35). The Examiner notes, Young teaches that the first carrier of the first country and the second carrier of the second country can be the same or different carrier.

17. Young does not teach printing on mail an indication of the amount of postage charged to the sender's meter for the first carrier's postage.

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18. Connell teaches printing on mail an indication of the amount of postage charged to the sender's meter for the first carrier's postage (Connell: Figure 2, "13" and column 3, line 1).

19. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included printing on mail an indication of the amount of postage charged to the sender's meter for the first carrier's postage as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

20. As per claim 6, Young teaches the method of claim 1 as described above. Young does not teach printing on mail an indication of the amount of postage charged to the sender's meter for the second carrier's postage.

21. Connell teaches printing on mail an indication of the amount of postage charged to the sender's meter for the second carrier's postage (Connell: Figure 2, "13" and column 3, line 1).

22. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included printing on mail an indication of the amount of postage charged to the sender's meter for the second carrier's postage as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

23. As per claim 9, Young teaches delivering an item containing the international business reply mail from a sender located in the first country to a recipient located in the second country (Young: Figure 1). Young teaches a consumer returns a product using a third-party delivery service (Young: column 2, lines 63-65).

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24. Young does not teach printing on the item an indication of the amount of postage charged to the sender's meter for the first carrier's postage; and printing on the business item an indication of the amount of postage charged to the sender's meter for the second carrier's postage.

25. Connell teaches printing on the item an indication of the amount of postage charged to the sender's meter for the first carrier's postage and printing on the business item an indication of the amount of postage charged to the sender's meter for the second carrier's postage (Connell: Figure 2, "13" and column 3, line 1). The Examiner defines "the item" to include both the item being delivered and the mailing envelope.

26. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included printing on the item an indication of the amount of postage charged to the sender's meter for the first carrier's postage and printing on the business item an indication of the amount of postage charged to the sender's meter for the second carrier's postage as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

27. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young, U.S. Patent No. 7,058,581 in view of Connell et al, U.S. Patent No. 5,554,842 and Walker et al., U.S. Patent No. 6,978,248.

28. As per claim 11, Young teaches charging a sender's meter located in the first country for postage that is due to the second carrier for processing business reply mail that is deposited by a recipient with the second carrier (Young: Figure 1); and charging a sender's meter located in the first country for postage that is due to the first carrier for business reply mail that is received

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from the second carrier and delivered to a party located in the first country (Young: Figure 1).

Young teaches a return system that allows a consumer to return a product using a third-party delivery service (Young: column 2, lines 63-65). Young further teaches a return label can contain a return center address and have pre-paid postage or billing of any type (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of mail to be charged to the original sender's meter. Young teaches the package delivery service includes international carriers such as the United Parcel Service or any international postal service (Young: column 4, lines 23-27). Young further teaches for international locations, any local delivery service can be used, including a foreign postal service (Young: column 4, lines 33-35). The Examiner notes, Young teaches that the first carrier of the first country and the second carrier of the second country can be the same or different carrier. Young further teaches delivering an item containing the international business reply mail from a sender located in the first country to a recipient located in the second country (Young: Figure 1). Young teaches a consumer returns a product using a third-party delivery service (Young: column 2, lines 63-65).

29. Young does not teach indicating information on mail.

30. Connell teaches indicating information on mail (Connell: Figure 2). Connell teaches postal indicia that contains information including a dollar amount, the date, and the postal serial number (Connell: column 3, lines 1-4).

31. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included indicating information on mail as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

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32. Young in view of Connell does not teach indicating the amount of mail that may be returned to the sender.

33. Walker teaches indicating the amount of mail that may be returned to the sender (Walker: Figure 6A, "628" and Figure 6B, "672"). Walker further teaches determining the number of responses that are received (Walker: Figure 6).

34. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young in view of Connell to have included indicating the amount of mail that may be returned to the sender as taught by Walker for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

35. As per claim 12, Young in view of Connell and Walker teaches the method of claim 11 as described above. Walker further teaches determining an expected business reply response factor for the international business reply mailing (Walker: column 11, lines 49-52). Walker teaches the response rate of each mailing list is calculated corresponding to the number of responses received (Walker: column 11, lines 49-52).

36. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young in view of Connell to have included determining an expected business reply response factor as taught by Walker for the advantage of providing an efficient and cost effective way of testing, selecting, and creating a mailing list that is appropriate to a business's needs (Walker: column 12, lines 20-23).

37. As per claim 13, Young in view of Connell and Walker teaches the method of claim 12 as described above. Connell further teaches determining a cost of mailing the expected business reply responses (Connell: Figure 2, "13"). Connell teaches postal indicia that displays the cost

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for sending mail through a delivery service (Connell: Figure 2, "13"). The Examiner notes, printing a shipping cost on mail (postal indicia) requires the prior step of determining the mailing cost.

38. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included determining a cost of mailing the expected business reply responses as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

39. As per claim 14, Young in view of Connell and further in view of Walker teaches the method of claim 13 as described above. Young further teaches charging the sender's meter for the cost of mailing the expected business reply responses (Young: column 3, lines 8-10). Young teaches a return label can contain a return center address and have pre-paid postage or billing of any type (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of mail to be charged to the original sender's meter.

40. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young, U.S. Patent No. 7,058,581 in view of Connell et al, U.S. Patent No. 5,554,842 and Walker et al., U.S. Patent No. 6,978,248 as applied to claim 14 above, and further in view of Baer et al., U.S. Patent No. 4,999,481.

41. As per claim 15, Young in view of Connell and Walker teaches the method of claim 14 as described above. Young in view of Connell and Walker does not teach counting the number of mail processed.

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42. Baer teaches counting the number of mail processed by the first and second carriers (Baer: column 6, lines 42-44). Baer teaches counting the number of mail pieces in a particular batch (Baer: column 6, lines 42-44).

43. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young in view of Connell and Walker to have included counting the number of mail processed as taught by Baer for the advantage of maintaining a record for a batch of mail (Baer: column 6, lines 56-60).

44. As per claim 16, Young in view of Connell and Walker and further in view of Baer teaches the method of claim 15 as described above. Connell further teaches determining the total amount of postage due to the first and second carrier for processing the counted international business reply mail (Connell: Figure 2, "13"). Connell teaches postal indicia that displays the cost for sending mail through a delivery service (Connell: Figure 2, "13"). The Examiner notes, printing a shipping cost on mail (postal indicia) requires the prior step of determining the postage.

45. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included determining the total amount of postage due to the first and second carrier for processing the counted international business reply mail as taught by Connell for the advantage of providing a postal indicia that is more versatile (Connell: column 2, lines 56-57).

46. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young, U.S. Patent No. 7,058,581 in view of Fredman, U.S. Patent No. 6,526,393.

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47. As per claim 17, Young teaches charging a sender's meter located in the first country for postage that is due to the second carrier for processing business reply mail that is deposited by a recipient with the second carrier (Young: Figure 1); and charging a sender's meter located in the first country for postage that is due to the first carrier for business reply mail that is received from the second carrier and delivered to a party located in the first country (Young: Figure 1). Young teaches a return system that allows a consumer to return a product using a third-party delivery service (Young: column 2, lines 63-65). Young further teaches a return label can contain a return center address and have pre-paid postage or billing of any type (Young: column 3, lines 8-10). The Examiner interprets pre-paid postage of mail to be charged to the original sender's meter. Young teaches the package delivery service includes international carriers such as the United Parcel Service or any international postal service (Young: column 4, lines 23-27). Young further teaches for international locations, any local delivery service can be used, including a foreign postal service (Young: column 4, lines 33-35). The Examiner notes, Young teaches that the first carrier of the first country and the second carrier of the second country can be the same or different carrier. Young further teaches delivering an item containing the international business reply mail from a sender located in the first country to a recipient located in the second country (Young: Figure 1). Young teaches a consumer returns a product using a third-party delivery service (Young: column 2, lines 63-65).

48. Young does not teach indicating on the mail the expiration date that the sender's meter will be charged for processing specific batches of reply mail.

49. Fredman teaches indicating on the mail the expiration date that the sender's meter will be charged for processing specific batches of international business reply mail (Fredman: Figure 1).

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Fredman teaches an "Urgent Reply Mail" envelope with a predetermined effective expiration date (Fredman: Figure 1 and column 2, lines 17-19).

50. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Young to have included indicating on the mail the expiration date that the sender's meter will be charged for processing specific batches of reply mail as taught by Fredman for the advantage of providing an important incentive to facilitate and increase a recipient's rate of response (Fredman: column 2, lines 38-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Thursday, 7:30-5:00 and Friday 7:30-4:00 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



PATRICK J. NOLAN, PH.D.
SUPERVISORY PATENT EXAMINER

12/4/06